

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

MEYNARD DESIGNS, INC. AND EARTH,
INC.

Plaintiffs and
Counterclaim-Defendants,

v.

EARTH PRODUCTS INC.

Defendant and
Counterclaim-Plaintiff.

EARTH PRODUCTS INC.

Third-Party Plaintiff and
Counterclaim-Defendant,

v.

PLANET, INC.

Third-Party Defendant and
Counterclaim-Plaintiff.

CIVIL ACTION NO. 05 cv 11781 NMG

**DERRICK W. TODDY DECLARATION IN SUPPORT OF EARTH PRODUCTS
INC.'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF INVALIDITY OF
UNITED STATES TRADEMARK REGISTRATIONS 2,249,826 AND 2,199,118**

I, Derrick W. Toddy, the undersigned, declare:

1. I am an attorney at law, and an associate at the law firm of Klarquist Sparkman, LLP, counsel for Earth Products Inc. ("Earth Products") in the above-captioned matter. I am over the age of 18 and competent to testify to the matters contained in this Declaration. I have personal knowledge of the matters stated herein unless indicated otherwise.

2. Attached as Exhibit A is a true and correct copy of the Trademark Application – Intent To Use filed with the United States Patent and Trademark Office (“PTO”) by Mondial Trading Co., Ltd. (“Mondial Trading”) on July 20, 1994.

3. Attached as Exhibit B is a true and correct copy of the Trademark Response/Amendment and Assignment filed with the PTO by Mondial Trading on September 26, 1997.

4. Attached as Exhibit C is a true and correct copy of selected portions of Meynard Design, Inc.’s Responses to Earth Products Inc.’s Third Set of Interrogatories, dated August 1, 2007.

5. Exhibit D is a true and correct copy of selected portions of Meynard Designs, Inc.’s Responses to Earth Products’ First Set of Interrogatories, dated December 8, 2006. Meynard Designs, Inc. declined to de-designate those portions of its responses that it originally designated subject to the Stipulated Protective Order. Exhibit D is separately filed under seal pursuant to the terms of the aforementioned Stipulated Protective Order and the Court’s October 26, 2007 Order granting Earth Products Inc.’s Motion to Impound Materials Cited In Earth Products’ Motion for Partial Summary Judgment of Invalidity of United States Trademark Registrations 2,249,826 and 2,199,118, and Designated as Confidential Under the Stipulated Protective Order.

6. Exhibit E is a true and correct copy of selected portions of the Transcript of the September 26, 2007 Deposition of Celso Kiefer. Meynard Designs, Inc. declined to de-designate those portions of the deposition transcript that it originally designated subject to the Stipulated Protective Order. Exhibit E is separately filed under seal pursuant to the terms of the aforementioned Stipulated Protective Order and the Court’s October 26, 2007 Order granting

Earth Products Inc.'s Motion to Impound Materials Cited In Earth Products' Motion for Partial Summary Judgment of Invalidity of United States Trademark Registrations 2,249,826 and 2,199,118, and Designated as Confidential Under the Stipulated Protective Order.

7. Exhibit F is a true and correct copy of selected portions of the Transcript of the October 2, 2007 Deposition of John Chopak. This deposition transcript was not prepared until October 15, 2007, and is automatically designated under the parties Stipulated Protective Order until 20 days after the parties receive it for review. Exhibit E is separately filed under seal pursuant to the terms of the aforementioned Stipulated Protective Order and the Court's October 26, 2007 Order granting Earth Products Inc.'s Motion to Impound Materials Cited in Earth Products' Motion for Partial Summary Judgment of Invalidity of United States Trademark Registrations 2,249,826 and 2,199,118, and Designated as Confidential Under the Stipulated Protective Order.

8. Attached as Exhibit G is a true and correct copy of the ITU Request for Extension of Time, Statement of Use, and Request to Divide, filed with the PTO by Mondial Trading on January 23, 1998.

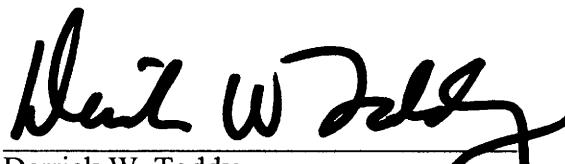
9. Attached as Exhibit H is a true and correct copy of the PTO's March 30, 1998 Office Action, from the file history of ITU Application Serial No. 75/977076.

10. Attached as Exhibit I is a true and correct copy of the Response to the PTO's March 30, 1998 Office Action and Substitute Statement of Use filed by Mondial Trading on July 23, 1998.

11. Attached as Exhibit J is a true and correct copy of the Statement of Use filed by Mondial Trading on January 20, 1999.

12. Attached as Exhibit K is a true and correct copy of the March 1, 2000 Assignment from Mondial Trading to Michel Meynard, Inc.

EXECUTED this 25th day of October, 2007, in Portland, Oregon.



Derrick W. Toddy
Counsel *pro hac vice* for Earth Products Inc.

CERTIFICATE OF SERVICE

I certify that this DERRICK W. TODDY DECLARATION IN SUPPORT OF EARTH PRODUCTS INC.'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF INVALIDITY OF UNITED STATES TRADEMARK REGISTRATIONS 2,249,826 AND 2,199,118 is being filed through the Court's electronic filing system, which serves counsel for other parties who are registered participants as identified on the Notice of Electronic Filing (NEF).

Counsel for other parties are also being served by electronic mail on the date of electronic filing.

Dated: October 25, 2007

By: /s/ Derrick W. Toddy
J. Christopher Carraway (*pro hac vice*)
Email: chris.carraway@klarquist.com
Cindy L. Caditz (*pro hac vice*)
Email: cindy.caditz@klarquist.com
Scott E. Davis (*pro hac vice*)
Email: scott.davis@klarquist.com
Derrick W. Toddy (*pro hac vice*)
Email: derrick.toddy@klarquist.com
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121 S.W. Salmon Street, Suite 1600
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Phone: 503-595-5300
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Steven M. Bauer, BBO# 542531
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kmottley@proskauer.com
PROSKAUER ROSE LLP
One International Place
Boston, Massachusetts 02110
Phone: 617-646-8000
Fax: 617-646-8646

Attorneys for Earth Products Inc.

EXHIBIT A

5308W

ATTY. DOCKET

M0849/2005 (DW)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mondial Trading Co. Ltd.
Serial No. : 17,756
Filed : JUL 21 1994
For : EARTH

U.S. PATENT & TRADEMARK OFFICE

75117076

ASSISTANT COMMISSIONER FOR
TRADEMARKS
2900 Crystal Drive
Box: ITU TM Appln.
Arlington, Virginia 22202-3513

Sir:

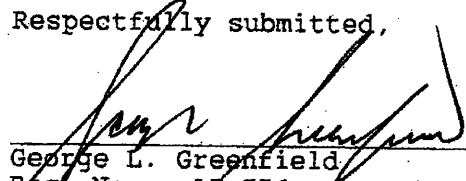
Transmitted herewith for filing is the following document:

[XX] Trademark Application - Intent to Use

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned collect at (617) 720-3500, Boston, Massachusetts.

A check in the amount of \$245.00 is enclosed to cover the filing fee. If the fee is insufficient, the balance may be charged to the account of the undersigned, Deposit Account No. 23/2825. A duplicate of this sheet is enclosed.

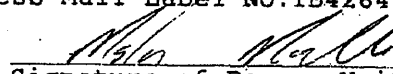
Respectfully submitted,


George L. Greenfield
Reg. No.: 17,756
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210
Tel. (617) 720-3500

DATE: 07-20-94
NDD

EXPRESS MAIL CERTIFICATE UNDER 37 C.F.R. §1.10

The undersigned hereby certifies that this document is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the 20th day of July 1994, Express Mail Label No. TB426440388US.


Signature of Person Mailing
Name: MARLON MELVILLE

5308W

ATTY. DOCKET

M0849/2005 (DW)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mondial Trading Co. Ltd.
Serial No. : ~~herewith~~
Filed ~~herewith~~
For ~~EARTH~~
JUL 26 1994

ASSISTANT COMMISSIONER FOR
TRADEMARKS

2900 Crystal Drive
Box: ITU TM Appln.
Arlington, Virginia 22202-3513

Sir:

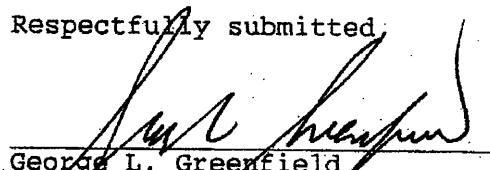
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A check in the amount of \$245.00 is enclosed to cover the filing fee. If the fee is insufficient, the balance may be charged to the account of the undersigned, Deposit Account No. 23/2825. A duplicate of this sheet is enclosed.

Respectfully submitted,

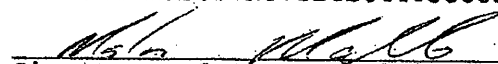

George L. Greenfield
Reg. No.: 17,756
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210
Tel. (617) 720-3500

DATE: 07-20-94

NDD

EXPRESS MAIL CERTIFICATE UNDER 37 C.F.R. §1.10

The undersigned hereby certifies that this document is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the 20th day of July 1994, Express Mail Label No. TB426440388US.


Signature of Person Mailing
Name: MARKON MELVILL

Intent to Use - Trademark

2401 301

ATTY DOCKET NO. [M0849/2005 (DW)]

DN
DW:mem
03-30-94
5272W

TRADE MARK ROOM

JUL 26 1994

MARK: EARTH
CLASS NO.: 25

75377076

03
Applicant:

Mondial Trading Co. Ltd. KYA
a corporation of the [Cayman Islands] ✓

AA
Business
Address
and Situs:

[P.O. Box 1109, Mary Street
Grand Cayman, [Cayman Islands B.W.I.]
KYA

To the Assistant Commissioner for Trademarks:

The above-identified applicant requests registration of the above-identified trademark/service mark shown in the accompanying drawing for [clothing, namely, socks, t-shirts, ~~jeans, pants, caps, belts, shirts, hats, sweatshirts, sweaters, jackets and coats~~] and hereby requests that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946. 25/32 JKC

Applicant has a bona fide intention to use the mark in ✓ commerce on or in connection with the above-identified goods/services. Applicant intends to use the mark on labels in ✓ connection with the sale of goods.

MSA > Applicant hereby appoints David Wolf, Reg. No. 17,528; George L. Greenfield, Reg. No. 17,756; Stanley Sacks, Reg. No. 19,900; David M. Driscoll, Reg. No. 15,075; Arthur Z. Bookstein, Reg. No. 22,958; Edward F. Perlman, Reg. No. 28,105; Lawrence M. Green, Reg. No. 29,384; Therese A. Hendricks, Reg. No. 30,389; Edward R. Gates, Reg. No. 31,616; Steven J. Henry, Reg. No.

- 2 -

27,900; William R. McClellan, Reg. No. 29,409; Ronald J. Kransdorf, Reg. No. 20,004; M. Lawrence Oliverio, Reg. No. 30,915; James J. Foster, Reg. No. 30,052; Charles E. Pfund, Reg. No. 17,030; Philip G. Koenig, Reg. No. 30,186; David B. Bernstein, Reg. No. 32,112; Theodore Naccarella, Reg. No. 33,023; Anthony J. Mirabito; Reg. No. 28,161; Jason M. Honeyman, Reg. No. 31,624; William A. Loginov, Reg. No. 34,863; Anthony J. Janiuk, Reg. No. 29,809; Peter C. Lando, Reg. No. 34,654; Richard F. Giunta, Reg. No. 26,149; Mark A. Fischer; Helen A. Greer, Reg. No. 36,816; Donald R. Steinberg; Douglas R. Wolf, Reg. No. 36,971; Randy J. Pritzker, Reg. No. 35,986; James H. Morris, Reg. No. 34,681; Elizabeth R. Plumer, Reg. No. 36,637; Brett N. Dorny, Reg. No. 35,860; Michael A. Diener; Peter M. Dichiaro; Michael J. Twomey; and Jay M. Fialkov, its attorneys to prosecute this application to register, to transact all business in the Patent and Trademark Office in connection therewith, and to receive the certificate of registration. Address all telephone calls to David Wolf at telephone number (617)720-3500. Address all correspondence to [David Wolf] Esq., [c/o: Wolf, Greenfield & Sacks, P.C., 600 Atlantic Avenue, Boston, Massachusetts 02210-2211.] Our telecopier number is (617)720-2441.

AT
CA

- 3 -

Caprice Scott-Leggatt being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, declares: That he is the Director of applicant corporation and is authorized to execute this declaration on behalf of said corporation; that he believes said corporation to be the owner of the trademark sought to be registered; that to the best of his knowledge and belief no other person, firm, corporation or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive; that the facts set forth in this application are true; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true. ✓

Mondial Trading Co. Ltd.

24th June, 1994 ✓
Date

BY: 
Name: Caprice Scott-Leggatt
Title: Director ✓

EXHIBIT B



Express Mail Label No. EM192426214US

ATTORNEY'S DOCKET NO. M0849/2005 (DW)
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mondial Trading Company, Limited
Serial No: 74/551611
Filed: July 20, 1994
Mark: EARTH

Examiner: Dana D. Austin
Law Office: ITU/Divisional unit

Box ITU
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VA 22202-3513

Sir:

Transmitted herewith is/are the following document(s):

- ☒ Trademark Response/Amendment
- ☒ Assignment

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617)720-3500, Boston, Massachusetts.

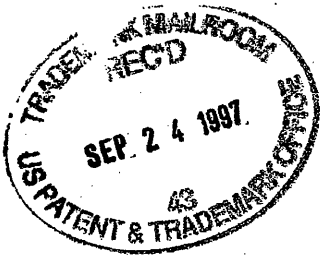
A check in the amount of \$0.00 is enclosed to cover the filing fee. If the fee is insufficient, the balance may be charged to the account of the undersigned, Deposit Account No. 23/2825. A duplicate of this sheet is enclosed.

Respectfully Submitted,

David Wolf
Reg. No. 17,528
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2211
(617)720-3500

Docket No. M0849/2005 (DW)
September 24/1997

x9/26/97



Express Mail Label No. EM192426214US

ATTORNEY'S DOCKET NO. M0849/2005 (DW)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mondial Trading Company, Limited
Serial No: 74/551611
Filed: July 20, 1994
Mark: EARTH

Examiner: Dana D. Austin
Law Office: ITU/Divisional unit

Box ITU
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VA 22202-3513

Sir:

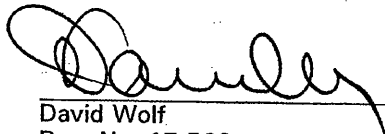
Transmitted herewith is/are the following document(s):

- ☒ Trademark Response/Amendment
- ☒ Assignment

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617)720-3500, Boston, Massachusetts.

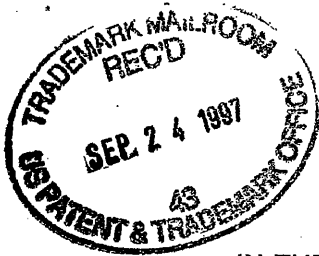
A check in the amount of \$0.00 is enclosed to cover the filing fee. If the fee is insufficient, the balance may be charged to the account of the undersigned, Deposit Account No. 23/2825. A duplicate of this sheet is enclosed.

Respectfully Submitted,


David Wolf
Reg. No. 17,528
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2211
(617)720-3500

Docket No. M0849/2005 (DW)
September 24/1997

x9/26/97



ITU

New Case
DRT

Express Mail Label No. EM192426214US

ATTORNEY'S DOCKET NO: M0849/2005 (DW)

REC'D
ACCEPTED
11/10

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mondial Trading Company, Limited
Serial No: 74/551611
Filed: July 20, 1994
Mark: EARTH

Examiner: Dana D. Austin
Law Office: ITU/Divisional Unit

ITU
WH
10/25

W/H

97 SEP 29 PM 3:44

ITU UNIT

Assistant Commissioner For Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

Your letter of August 27, 1997 in the above identified case is acknowledged.

Herewith submitted is an assignment from the original applicant to the entity that executed the Statement of Use with an effective date of June 25, 1997.

Applicant believes this submission complies with the requirement of the Applications Examiner. Acceptance of the Request for Extension of Time is solicited.

Respectfully submitted,

David Wolf, Reg. No. 17,528
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02110
(617) 720-3500

09/23/97 TUE 16:48 FAX

MIDLAND TRUST

002

M0849/2005 (DW)

ASSIGNMENT

WHEREAS, Mondial Trading Company, Ltd., a corporation of the Cayman Islands having an office and place of business at P.O. Box 1109, Mary Street, Grand Cayman, Cayman Islands B.W.I. has adopted and used the following marks and the trademark Registrations:

SCHEDULE OF TRADEMARKS

MARK	Application No.	Filing Date
EARTH	74/551611	July 20, 1994

WHEREAS, Michel Meynard, Inc., a corporation of Massachusetts, having an office and place of business at 763 Salem End Road Framingham, MA 01702-5542 is desirous of acquiring said mark and the registrations therefor.

NOW, THEREFORE, for one Dollar (\$1.00) and other good and valuable consideration, the receipt of which is hereby acknowledged, said Mondial Trading Company, Ltd. without representations or warranties with respect to said trademarks or registrations or the title thereto does hereby assign unto the said Michel Meynard, Inc., all its rights, title and interest in and to the said marks and the registrations therefor, together with the goodwill of the business symbolized by said marks and the registrations therefor and including all rights to sue and recover for past infringement of said marks and the registrations therefor. Effective as of June 25, 1997.

Mondial Trading Company, Ltd.

By Kareen Watler

Name: Kareen Watler

Title: Director

RECEIVED

SEP 5 1997

OFFICE OF THE SECRETARY OF STATE

138400.1

EXHIBIT C

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

MEYNARD DESIGNS, INC. AND EARTH
VISIONS INC.,

Plaintiffs and Counterclaim
Defendants,

v.

EARTH PRODUCTS INC.,

Defendant and Counterclaim
Plaintiff.

CIVIL ACTION NO. 05 CV 11781
NMG

EARTH PRODUCTS INC.

Third Party Plaintiff,

v.

PLANET, INC.

Third-Party Defendant.

**MEYNARD DESIGNS, INC.'S RESPONSE TO
EARTH PRODUCTS' THIRD SET
OF INTERROGATORIES (NOS. 23-32)**

Plaintiff Meynard Designs, Inc. ("Meynard"), hereby responds to Earth Products' Third Set of Interrogatories.

GENERAL OBJECTIONS

A. Meynard objects to each and every interrogatory insofar as any such request seeks information protected by the work product doctrine, subject to the attorney-client privilege, prepared or assembled in anticipation of litigation, subject to federal or state law prohibiting disclosure, or otherwise not within the scope of discovery under Fed. R. Civ. P. 26.

or designed, developed, made or assembled in the United States, including identification of the specific involvement of each Meynard Party and the corresponding time period.

ANSWER TO INTERROGATORY NO. 25

Meynard objects to this interrogatory as it is compound and ambiguous. The interrogatory, especially if consideration is given to the definitions, is unintelligible. Moreover, the interrogatory relates to persons and entities that are not parties to this suit and are irrelevant to the claims and defenses in this trademark infringement action. To the extent the request seeks information relating to production and sale of goods other than the accused non-footwear clothing, it is overly broad and irrelevant. Meynard further objects as this request is unduly burdensome and calculated not to discover admissible evidence, but for purposes of harassment.

Earth, Inc. licenses the EARTH marks, among other marks, from Meynard Designs, Inc. Earth, Inc. sells a number of goods under the EARTH marks, among other marks, mainly to retailers for resale. Planet, Inc. is a retailer of goods of many brands, including those bearing the EARTH marks. Mondial Trading Co. Ltd. was the owner of the EARTH marks from 1994. It licensed those marks to Meynard. No further information is relevant to this dispute.

INTERROGATORY NO. 26

State the basis for your contention that Meynard received a valid license from Mondial Trading to use the EARTH Mark and EARTH SHOE Mark in association with clothing (*see* Meynard's response to Interrogatory No. 11), including without limitation, the effective date of the license, the royalty terms and total royalties paid, the basis for Mondial Trading's alleged rights in the EARTH and EARTH SHOE Marks for use in association with clothing, any quality control rights, terms or requirements included in the license, any quality control procedures implemented by Mondial Trading, identification of the persons involved in the negotiation of the

license on behalf of Mondial Trading, identification of the persons involved in the negotiation of the license on behalf of Meynard, and identification of all documents that refer or relate to or evidence the alleged license arrangement.

ANSWER TO INTERROGATORY NO. 26

Meynard objects to this interrogatory as it is compound, ambiguous and constitutes more than one interrogatory. Meynard also objects to the request to identify all documents, in lieu of such identification, non-privileged documents will be produced. Subject to its objections, Meynard responds as follows:

Meynard was given an oral license to make use of the EARTH marks at some point in 1994. The presentations by Meynard to Wal-Mart in 1994 (as described in other discovery responses), which contained clothing, show that the license was effective prior to the first meeting. From its formation, the license was continuous throughout Mondial's ownership of the EARTH marks. Evidence of this license includes an agreement between Bradford License Associates (M003007) and Meynard relating to goods including clothing, effective March 20, 1996, making note that Meynard was a licensee. Further, Mondial approved of Meynard's use of the EARTH marks on clothing, and, in fact, used a specimen used by Meynard in relation to its trademark applications for clothing. Quality control provisions were the same or similar to provisions in the previously produced, written footwear license between Meynard and Mondial. The license was established in communications between Michel Meynard and Pierre Meynard, although others representing Mondial may have been involved. Pierre Meynard was given and shown samples of goods and catalogs of Meynard's production regularly during visits between Michel Meynard, Philippe Meynard, and Arlette Meynard and Pierre Meynard in France, about four times a year. In addition, Michel and Pierre at spoke least weekly from 1994 to 2000,

during which time information about the EARTH business was exchanged. As previously disclosed, Pierre controlled Mondial. In addition, over time Pierre shifted control of Mondial's business line relating to the EARTH marks to Michel as his agent, and Michel began to act as agent for Pierre and Mondial. Meynard did not pay royalties as a result of the familial relationship between Pierre Meynard and Michel Meynard.

Meynard objects to the independent request for the basis of Mondial's rights to EARTH for non-footwear clothing, as seeking legal analysis or privileged or work product information. Subject to the objections, Mondial had effective nationwide rights as of the filing date of its trademark application for EARTH for various clothing items. Even without the rights stemming from the registrations of the mark EARTH for clothing items, Mondial had acquired the registrations and common law rights to the EARTH marks for footwear, which included the right to use the marks on all goods and services within its natural zone of expansion, such as non-footwear clothing.

Pursuant to Fed. R. 33(d), any documents still in existence relating to the license will be, or have been, produced.

INTERROGATORY NO. 27

State the basis for your contention that there was no fraud or unclean hands involved in the submission of the assignment of U.S. Trademark Application Serial No. 74/551611 from Mondial Trading to Meynard effective June 25, 1997 (bates No. M0028) to the U.S. Patent and Trademark Office, including without limitation, identification of the persons involved in the negotiations on behalf of Meynard, the persons involved in the negotiations on behalf of Mondial Trading, the consideration paid by Meynard for the assignment, identification of the persons who prepared the assignment document, the reason for executing the assignment of U.S. Trademark

Registration No. 2,199,118 and U.S. Trademark Registration No. 2,249,826 in March 2000 (bates No. M003280) and the consideration paid by Meynard for this assignment, and all documents that refer or relate to one or both of the assignments.

ANSWER TO INTERROGATORY NO. 27

Meynard objects to the compound nature of this interrogatory. In connection with the many parts of the other interrogatories, Earth Products' requests well exceed 50 interrogatories. Accordingly, Meynard has no obligation to respond to this interrogatory.

Earth Products has the burden to prove fraud occurred. Meynard's contention that there was no fraud is, at least in part, based on the complete absence of evidence of fraud presented by Earth Products. Meynard provides the following additional information.

The assignment to the USPTO was a document that accurately reflected an assignment from Mondial to Meynard. The persons involved on behalf of Meynard were Michel Meynard and counsel. At various times, Michel Meynard interacted with Pierre Meynard to obtain authorization for various transactions between the companies. Over time, Michel Meynard was granted authorization by Pierre Meynard to act as agent for Pierre and Mondial for purposes of taking various corporate actions relating to the EARTH marks on behalf of Mondial. Pierre relied heavily on his son in matters pertaining to Mondial's ownership and development of the EARTH business. To the best of Michel's memory, the assignment resulted from either Pierre's decision or Michel's decision as an agent for Pierre and Mondial with respect to the EARTH marks. The assignment document was prepared by counsel for Meynard and Mondial. There was little negotiation between the parties with relation to the assignment, because they had been working closely and the controlling persons had a close family relationship. As to consideration, aside from that recited in the assignment document, in many instances Pierre Meynard, Michel's

father, made gifts from his company to Meynard. Both were closely-held family businesses, and as commonly occurs in such situations, assets were from time to time conveyed from one to the other, in consideration of the close family relationship between the persons who owned, controlled, and operated these companies.

The documents reflected Mondial, Meynard, and its attorneys' good faith beliefs as to the nature of the ownership of the application at the time.

Like the June 25, 1997 assignment, the later assignment was an accurate recitation of a transfer of rights and goodwill from Mondial to its long time licensee (and company owned by Pierre Meynard's son). As noted above, as between Mondial and Meynard, assets were occasionally transferred. In this case, in late 1997 or early 1998, the rights for EARTH for clothing were assigned back to Mondial from Meynard. As a result of the 1997 or 1998 assignment back to Mondial, in 2000, when Mondial decided to assign all rights to Michel Meynard's company, it was also necessary to assign the rights to EARTH for clothing, including the two registrations for EARTH for various clothing items. As with the prior assignment between Mondial and Meynard, to the best of Meynard's knowledge, the assignment was a gift in consideration of the familial relationship between Michel and Pierre and the fact that Michel's company had been a longtime licensee of the marks. The 2000 assignment from Mondial to Meynard was prepared by their trademark counsel. There was little or no negotiation, as Pierre and Michel generally agreed the transfer should take place.

INTERROGATORY NO. 28

For each Meynard Family Member who has had and/or does have a Relationship with a Meynard Entity, describe in detail the Relationship, including, if the nature or scope of the Relationship has changed over time, the time period for each phase of the Relationship.

obligations, Meynard will calculate damages and supplement this interrogatory. In addition to damages resulting from Earth Products' sales, Meynard will seek attorneys fees or other enhanced damages, which cannot be calculated until the close of the litigation.

INTERROGATORY NO. 30

Describe all relevant facts and circumstances regarding the invoices from International Shoe produced at bates Nos. M003649-68, including without limitation, explanation of the role of International Shoe in connection with the clothing items listed in the invoices; explanation of the role of MDA, Ltd. (see facsimile header on documents) in connection with the clothing items listed in the invoices, the document produced at bates No. M003649 itself, and/or any of the business transactions underlying the document produced at bates No. M003649; explanation of who "Earth.com, Inc." identifies in view of the fact that Earth.com, Inc. apparently was formed in February 1999 and the invoices are dated 1998; and identification of the person who signed the invoices as "Ellen."

ANSWER TO INTERROGATORY NO. 30

Meynard objects to the compound nature of this interrogatory. In connection with the many parts of the other interrogatories, Earth Products' requests well exceed 50 interrogatories. Accordingly, Meynard has no obligation to respond to this interrogatory. Meynard also objects to the interrogatory as vague and ambiguous. In addition, the interrogatory lacks foundation for the allegation that Earth.com was not formed until 1999; 1999 is simply the date of its incorporation.

In 1998, Earth.com was informally founded by Philippe Meynard and Michel Meynard, with the consent and aid of Meynard for the purpose of selling various goods, including footwear and non-footwear clothing bearing the EARTH marks at the retail level, mainly through the

internet. The business of Earth.com was ultimately divided, into the internet retail business, which is now Planet, Inc., and Earth Footwear division, which is now Earth, Inc. Starting in 1998, Earth.com ordered from foreign suppliers, with authorization of Meynard Designs, Inc., various non-footwear clothing items bearing the EARTH marks, which order is evidenced by the documents noted in this interrogatory. The purpose of this order was to obtain non-footwear clothing bearing the EARTH marks for sale by Earth.com, with trademark usage inuring to the benefit of Meynard. Earth.com sold or distributed on a promotional level these items. Orders and invoices evidencing sale of the items, to the extent available, have been produced by Planet.

Given the passage of time, no further documents relating to this specific purchase of clothing by Earth.com are available. Meynard believes that the order would have been placed by Philippe Meynard, who may have been in China at the time.

With respect to the role of IST, IST is a third party trading company for various factories. Thus, Earth.com would have issued payment to IST. Earth.com and Meynard have and still do work with IST for procurement of goods from various factories. IST is and was unrelated to Meynard or Earth.com. "Ellen" is an employee of IST and presumably could be contacted through IST.

With respect to MDA, Meynard does not currently know what was MDA's role or what entity is reflected on the fax line of the recited invoices.

INTERROGATORY NO. 31

State the basis for your contention that Plaintiffs are entitled to claim the benefit of use of the EARTH and EARTH SHOE Marks by Wal-Mart despite the fact that Plaintiffs represent to consumers that "Earth and Earth shoes are completely different brands. ... Don't be fooled." and

JURAT

On behalf of the Meynard, I have read the foregoing responses to interrogatories. Said responses were prepared by or with the assistance of agents, employees, and/or representatives of Meynard and/or others believed to have relevant information, and with the assistance and advice of counsel, upon which I have relied. The responses set forth herein, subject to inadvertent or undiscovered errors or omissions, are based on, and therefore necessarily limited by, the records and information still in existence, presently recollected, thus far discovered in the course of the preparation of these responses, and currently available to Meynard. Consequently, Meynard reserves the right to make any changes or additions to any of these responses if it appears at any time that errors or omissions have been made therein or that more accurate or complete information has become available. Subject to the limitations set forth herein, the said responses are true to the best of my present knowledge, information and belief. I certify under penalty of perjury on behalf of Meynard that the foregoing is true and correct.

Dated: 7/31/07



Name: Michel Meynard
Title: CEO
Meynard Designs, Inc.

As to objections and reservations of rights

Dated: 8/1/07



Michael Albert, BBO # 558566
malbert@wolfgreenfield.com
Laura Topper, BBO # 652364
ltopper@wolfgreenfield.com
Hunter Keeton, BBO #660609
hkeeton@wolfgreenfield.com
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210
Tel. 617 646.8000
Fax 617 646.8646

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

<p>MEYNARD DESIGNS, INC. AND EARTH, INC.</p> <p>Plaintiffs and Counterclaim-Defendants,</p> <p>v.</p> <p>EARTH PRODUCTS INC.</p> <p>Defendant and Counterclaim-Plaintiff.</p>	<p>Civil No. 1:05-CV-11781 NMG</p> <p>Judge Nathaniel M. Gorton</p>
<p>EARTH PRODUCTS INC.</p> <p>Third-Party Plaintiff and Counterclaim-Defendant,</p> <p>v.</p> <p>PLANET, INC.</p> <p>Third-Party Defendant and Counterclaim-Plaintiff.</p>	<p><u>CONTAINS CONFIDENTIAL INFORMATION SUBJECT TO A PROTECTIVE ORDER</u></p> <p>FILED UNDER SEAL WITH THE COURT IN ACCORDANCE WITH THE ASSENTED-TO MOTION TO FILE UNDER SEAL, FILED ON OCTOBER 25, 2007 (DOCKET #60) and PER ORDER DATED OCTOBER 26, 2007</p>

EXHIBIT D

FILED UNDER SEAL

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

<p>MEYNARD DESIGNS, INC. AND EARTH, INC.</p> <p>Plaintiffs and Counterclaim-Defendants,</p> <p>v.</p> <p>EARTH PRODUCTS INC.</p> <p>Defendant and Counterclaim-Plaintiff.</p>	<p>Civil No. 1:05-CV-11781 NMG</p> <p>Judge Nathaniel M. Gorton</p>
<p>EARTH PRODUCTS INC.</p> <p>Third-Party Plaintiff and Counterclaim-Defendant,</p> <p>v.</p> <p>PLANET, INC.</p> <p>Third-Party Defendant and Counterclaim-Plaintiff.</p>	<p><u>CONTAINS CONFIDENTIAL INFORMATION SUBJECT TO A PROTECTIVE ORDER</u></p> <p>FILED UNDER SEAL WITH THE COURT IN ACCORDANCE WITH THE ASSENTED-TO MOTION TO FILE UNDER SEAL, FILED ON OCTOBER 25, 2007 (DOCKET #60) and PER ORDER DATED OCTOBER 26, 2007</p>

EXHIBIT E

FILED UNDER SEAL

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

MEYNARD DESIGNS, INC. AND EARTH, INC. Plaintiffs and Counterclaim-Defendants, v. EARTH PRODUCTS INC. Defendant and Counterclaim-Plaintiff.	Civil No. 1:05-CV-11781 NMG Judge Nathaniel M. Gorton
EARTH PRODUCTS INC. Third-Party Plaintiff and Counterclaim-Defendant, v. PLANET, INC. Third-Party Defendant and Counterclaim-Plaintiff.	<u>CONTAINS CONFIDENTIAL INFORMATION SUBJECT TO A PROTECTIVE ORDER</u> FILED UNDER SEAL WITH THE COURT IN ACCORDANCE WITH THE ASSENTED-TO MOTION TO FILE UNDER SEAL, FILED ON OCTOBER 25, 2007 (DOCKET #60) and PER ORDER DATED OCTOBER 26, 2007

EXHIBIT F

FILED UNDER SEAL

EXHIBIT G

Express Mail Label No. EM529450234US

ATTORNEY'S DOCKET NO. M0849/2005 (DW)
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mondial Trading Company, Ltd.
Serial No: 74/551611
Filed: July 11, 1995
Mark: EARTH

Examiner: David J. Cho
Law Office: 10

Box ITU FEE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VA 22202-3513

Sir:

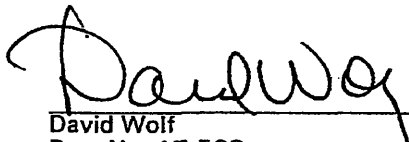
Transmitted herewith is/are the following document(s):

- ☒ ITU Request For Extension of Time Under 37 CFR 2.89 To File a Statement of Use, With Declaration
- ☒ ITU Statement of Use Under 37 CFR 2.88, With Declaration
- ☒ Request to Divide Application
- ☒ Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617)720-3500, Boston, Massachusetts.

A check in the amount of \$300.00 is enclosed to cover the filing fee. If the fee is insufficient, the balance may be charged to the account of the undersigned, Deposit Account No. 23/2825. A duplicate of this sheet is enclosed.

Respectfully Submitted,


David Wolf
Reg. No. 17,528
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2211
(617)720-3500

Docket No. M0849/2005 (DW)
1/23/98

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MIDLAND BANK

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.GREENFIELD SACKS617 720 2441 TO

9999997777#1 P.08

Attorney Docket No. M0849/2005 (DW)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mondial Trading Company, Ltd.
Serial No. : 74/551611
Filed : July 20, 1994
Mark : EARTH
Class : 25
Examiner : David J. Cho
Law Office : 10
Notice of Allowance : January 23, 1996

REQUEST TO DIVIDE APPLICATION

The Applicant hereby requests that the application identified above be divided as follows:

Please retain in the original application the following goods: jeans, pants, belts, shirts, sweaters, jackets, coats.

Please include in the new, divided application the following goods: socks, t-shirts, caps, hats, sweatshirts.

Respectfully submitted,

Mondial Trading Company, Ltd.

By:

Kareen Watter
Name: KAREEN WATTER
Title: DIRECTOR

*** TOTAL PAGE.08 ***

01/21/98 WED 11:40 [TX/RX NO 7572] 008

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PAGE 02

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006

ATTORNEY'S DOCKET NO. M0849/2005 (DW)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mondial Trading Company, Ltd.
Serial No: 74/551611
Filed: July 20, 1994
Mark: EARTH
Class No: 25
Examiner: David J. Cho
Law Office: 10
Notice of Allowance Mailing Date: January 23, 1996

**REQUEST FOR EXTENSION OF TIME UNDER 37 CFR 2.89
TO FILE A STATEMENT OF USE, WITH DECLARATION**

Assistant Commissioner For Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sirs:

Applicant requests a six-month extension of time to file the Statement of Use under 37 CFR 2.88 in this application.

A Request to Divide under 37 CFR 2.87 is being submitted with this request.

Applicant has a continued bona fide intention to use the mark in commerce in connection with those goods identified in the Notice of Allowance in this application except: jeans, pants, belts, shirts, sweaters, jackets, coats.

This is the 4th Request for an Extension of Time following mailing of the Notice of Allowance.

If this is not the first Request for an Extension of Time, check one box below. If the first box is checked, explain the circumstance(s) of non-use in the space provided:

Box 4 ☒ Applicant has not used the mark in commerce yet on all services specified in the Notice of Allowance; however, applicant has made the following ongoing efforts to use the mark in commerce on or in connection with each of the goods specified above:

THE COMPANY IS PRESENTLY NEGOTIATING

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0007

2

WITH WALMART FOR THEM TO USE THE
EARTH MARK ON THE PRODUCTS
LISTED.

Box 5 [] Applicant believes that it has made valid use of the mark in commerce, as evidenced by the Statement of Use submitted with this request; however, if the Statement of Use is found by the Patent and Trademark Office to be fatally defective, applicant will need additional time in which to file a new statement.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this Request for Extension of Time to File A Statement of Use on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered; and all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

23 January 1998
 Date

Alexander
 Signature

345-949-7755
 Telephone No.

KAREN WATLER - DIRECTOR
 Print or Type Name and Position

151248.1

-2-

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9999997777#1 P.03

ATTORNEY'S DOCKET NO. M0849/2005 (DW)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mondial Trading Company, Ltd.
Serial No : 74/551611
Filed : July 20, 1994
Mark : EARTH
Class : 25
Examiner : David J. Cho
Law Office : 10
Notice of Allowance Issue Date : January 23, 1996

STATEMENT OF USE UNDER 37 CFR §2.88, WITH DECLARATION

Box ITU Fee
Assistant Commissioner For Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

Applicant requests registration of the above-identified trademark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et. seq., as amended).

Three (3) specimens showing the mark as used in commerce are submitted with this statement.

A Request to Divide under 37 CFR 2.87 is being submitted with this statement.

Applicant is using the mark in commerce on or in connection with those goods identified in Notice of Allowance, EXCEPT: jeans, pants, belts, shirts, sweaters, jackets, coats.

The date of first use of the mark anywhere is: 2/1/95.

The date of first use of the mark in commerce which the U.S. Congress may

-1-

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PAGE 03

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regulate is: 2/1/95.

The type of commerce in which the mark is used is: interstate.

The manner or mode of use of the mark on or in connection with the goods is:
applied to labels and packaging and in other ways customary to the trade.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this Statement of Use on behalf of the applicant; he believes the applicant to be the owner of the trademark sought to be registered; the trademark is now in use in commerce; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Mondial Trading Company, Ltd.

23 January 1998
Date

By:

Kareen Warner
Name: KAREEN WARNER
Title: DIRECTOR

151253.1

-2-

01/21/98 WED 11:40 [TX/RX NO 7572] 004

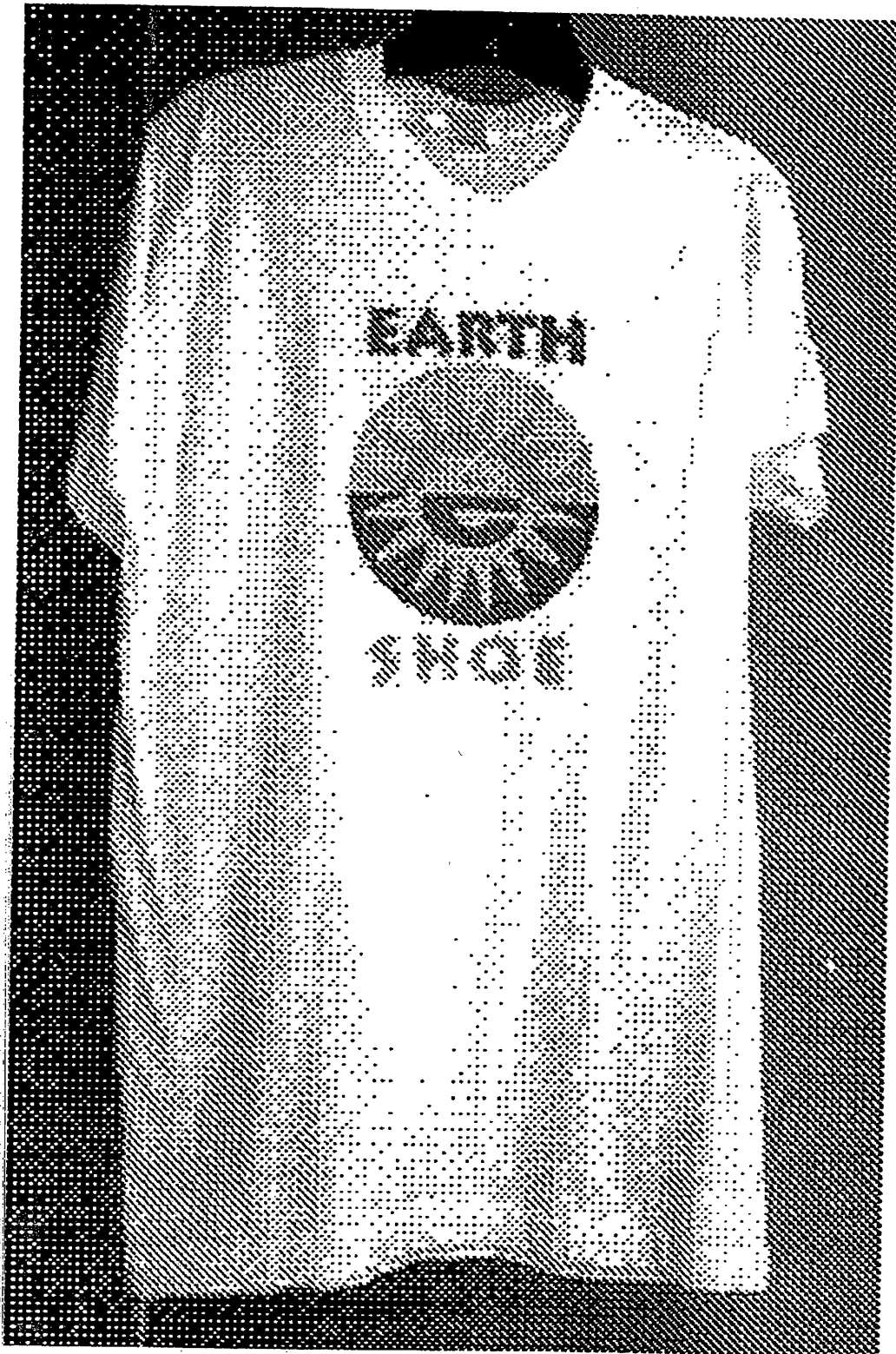
JAN 23 1998 15:27

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05cv11781

From: michel.morin To: David Wolf

Date: 1/23/98 Time: 3:15:10 PM

Page 2 of 2



JAN 23 '98 15:16

508-820-4482 michel

PAGE 02

M003531
05cv11781

FILING RECEIPT FOR TRADEMARK DIVISIONAL APPLICATION

Receipt of the divisional application request and filing fee is acknowledged for the MARK identified below. The divisional application has been given the DATE OF FILING of its corresponding PARENT SERIAL NUMBER set forth below. Further processing of the divisional application will occur in accordance with the standard procedure of the Patent and Trademark Office. When inquiring about the divisional application, include the SERIAL NUMBER, DATE OF FILING, OWNER NAME and MARK.

David Wolf
 c/o Wolf, Greenfield & Sacks, P.C.
 600 Atlantic Avenue
 Boston, MA 02210-2211

**ATTORNEY
 REFERENCE NUMBER**
 M0849.2005

PLEASE REVIEW THE ACCURACY OF THE FILING RECEIPT DATA.

A request for correction to the filing receipt should be submitted within 30 days to the following address: ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3513. The correspondence should be marked to the attention of the Office of Trademark Program Control. The Patent and Trademark Office will review the request and make corrections when appropriate.

SERIAL NUMBER: 75/977076
 FILING DATE: Jul 20, 1994
 REGISTER: Principal
 LAW OFFICE: 108
 MARK: EARTH
 MARK TYPE(S): Trademark
 DRAWING TYPE: Words, letters, or numbers in typed form
 FILING BASIS: Sect. 1(b) (Intent to Use)

PARENT SERIAL NUMBER: 74/551611

ATTORNEY: David Wolf

DOMESTIC REPRESENTATIVE: David Wolfe

OWNER: Mondial Trading Co. Ltd. (CAYMAN ISLANDS, Corporation)
 P.O. Box 1109, Mary Street
 Grand Cayman, CAYMAN ISLANDS

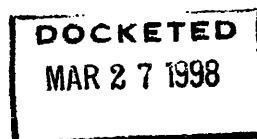
FOR: clothing, namely socks, T-shirts, caps, hats, sweatshirts
 INT. CLASS: 025
 FIRST USE: Feb 1, 1995 USE IN COMMERCE: Feb 1, 1995

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

OTHER DATA

OWNER OF U.S. REG. NOS.: 1294415, 1371439, 1372733, 1699166 and others

File Folder	<input checked="" type="checkbox"/>	INITIAL
Electronic Code Book	<input checked="" type="checkbox"/>	
Docket Entry	<input checked="" type="checkbox"/>	23.98
Docket Cross Off	<input checked="" type="checkbox"/>	
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Annulties	<input type="checkbox"/>	
Other	<input type="checkbox"/>	





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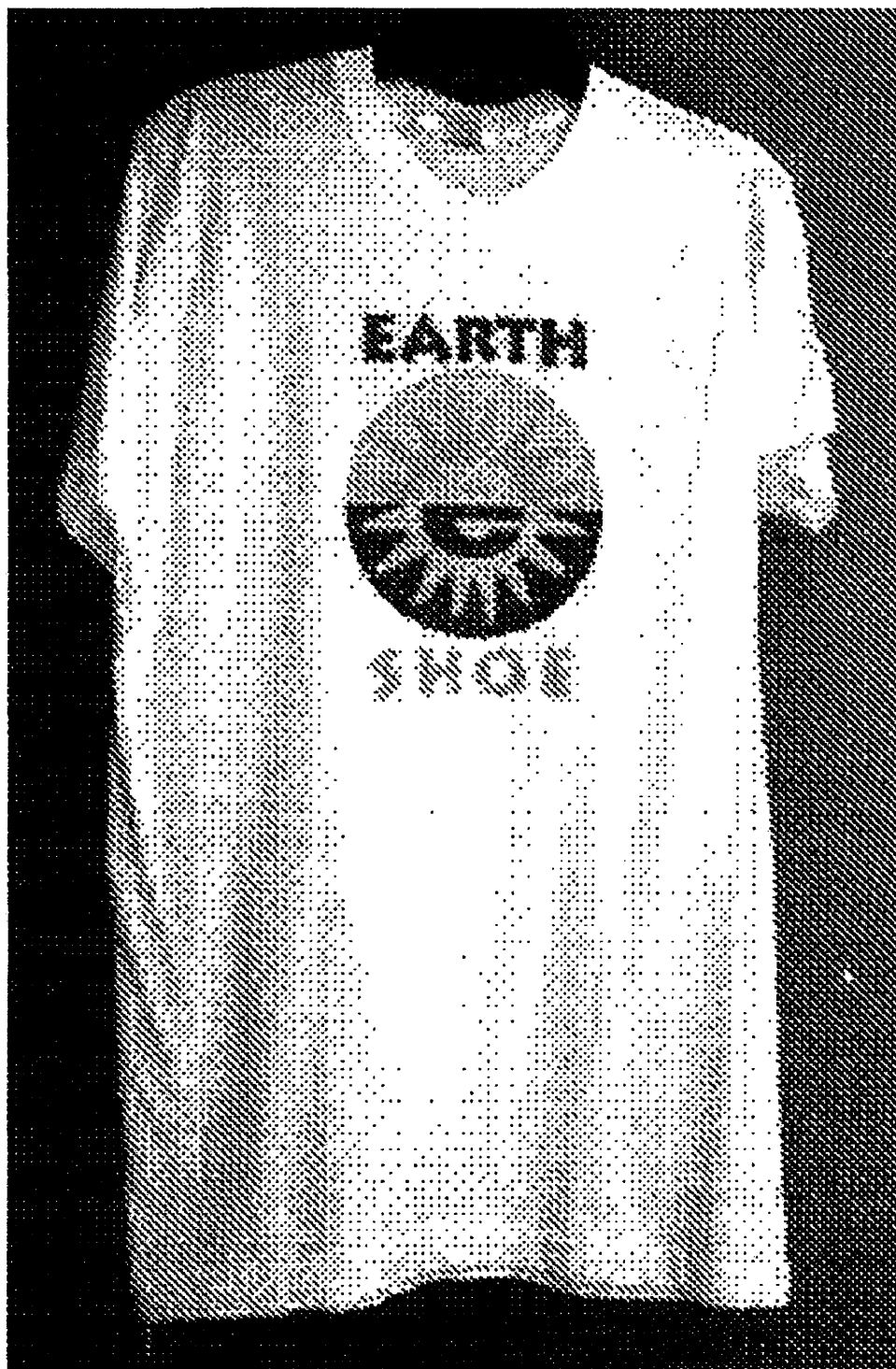
JAN 23 1998

WOLF, GREENFIELD & SACKS, P.C.

From: michel mobile To: David Wolf

Date: 1/23/98 Time: 3:15:10 PM

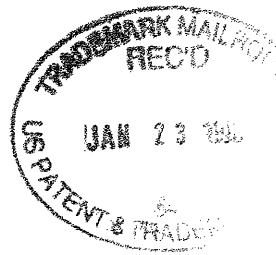
Page 2 of 2



JAN 23 '98 15:16

508-820-4482 michel

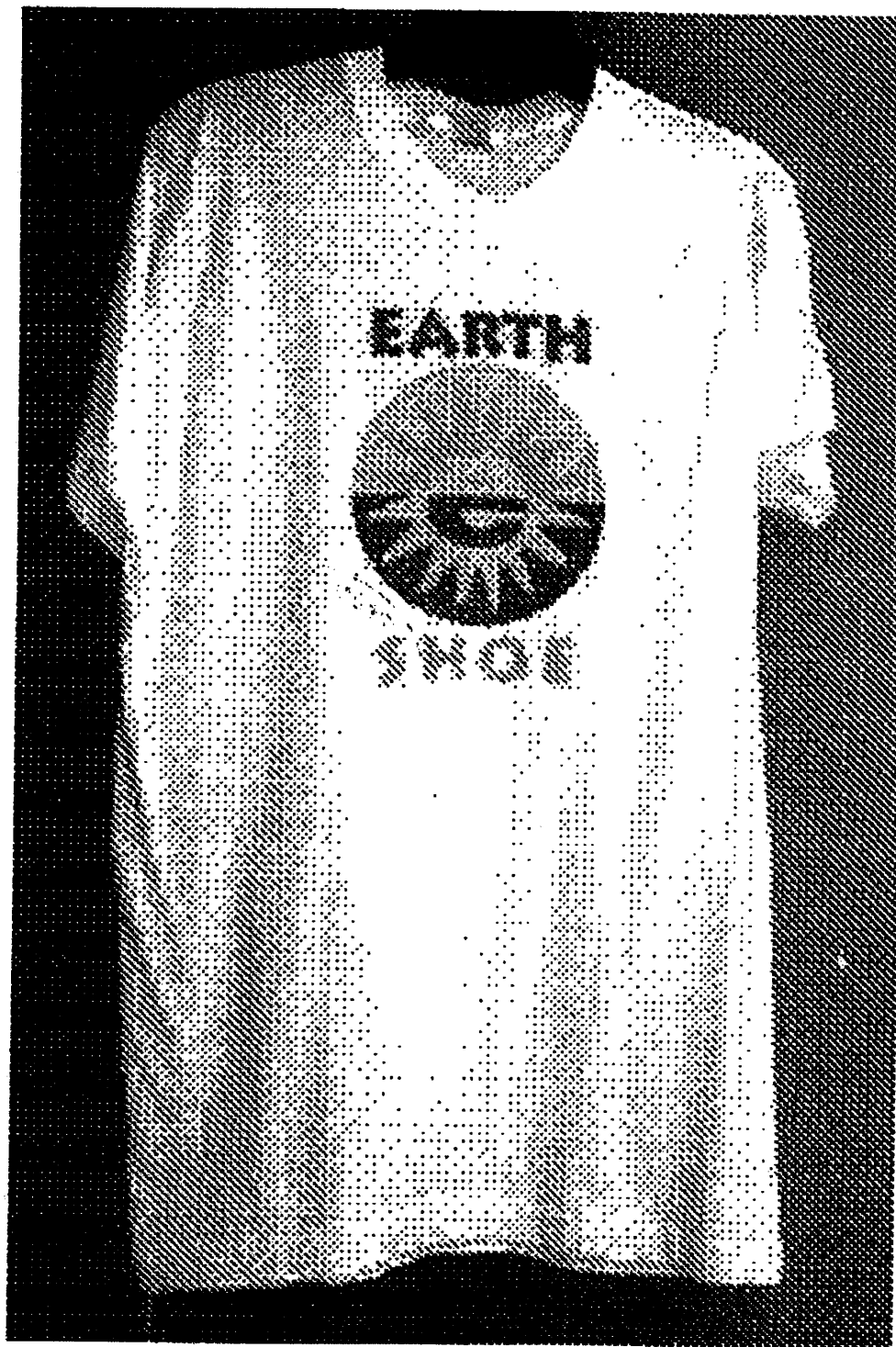
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From: michel mobile To: David Wolf

Date: 1/23/98 Time: 3:15:10 PM

Page 2 of 2



JAN 23 '98 15:16

508-820-4482 michel

PAGE.02



From: michel.mohle To: David Wolf

Date: 1/23/98 Time: 3:15:10 PM

Page 2 of 2



JAN 23 '98 15:16

508-820-4482 michel

PAGE.02

EXHIBIT H

DW

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

File Folder 6-30-98	<input checked="" type="checkbox"/>	INITIAL
Electronic Code Book	<input checked="" type="checkbox"/>	
Docket Entry	<input checked="" type="checkbox"/>	
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Annuities 9-30-98	<input checked="" type="checkbox"/>	
Other	<input checked="" type="checkbox"/>	

APR 4 1998

SERIAL NO.

75/977076 Mondial Trading Co., Ltd.

APPLICANT

MARK

EARTH

ADDRESS

David Wolf
c/o Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2211

ADDRESS:

Assistant Commissioner
for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

ACTION NO.

01

MAILING DATE

03/30/98

REF. NO.

M0849.2005

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

Please provide in all correspondence:

1. Filing Date, serial number, mark and Applicant's name.
2. Mailing date of this Office action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and ZIP code.

FORM PTO - 1525 (5-98)

U.S. DEPT. OF COMM. PAT. & TM OFFICE

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.

For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/977076

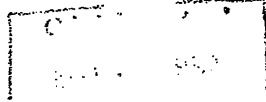
This letter responds to the applicant's communication filed on January 23, 1998.

The drawing displays the mark as EARTH. However, this differs from the display of the mark on the specimens, where it appears as EARTH SHOE. The applicant cannot amend the drawing to conform to the display on the specimens because the character of the mark would be materially altered. 37 C.F.R. Section 2.72(a); TMEP section 807.14(a).

Therefore, the applicant must submit substitute specimens which show use of the mark as it appears on the drawing. 37 C.F.R. Section 2.51; TMEP section 807.14. The applicant must verify, with an affidavit or a declaration under 37 C.F.R. Section 2.20, that the substitute specimens were in use in commerce prior to the expiration of the time allowed to the applicant for filing a statement of use. 37 C.F.R. Sections 2.59(b) and 2.72(c); TMEP section 905.10.

In addition, based upon the specimens submitted with the Statement of Use, the examining attorney issues the following refusal.

ORNAMENTATION REFUSAL



Woff, Greenfield & Sacks, P.C.
LEGAL SERVICES DEPT.

APR 2 - 1998

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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Decket Entry	<input checked="" type="checkbox"/>	
Decket Cross Off	<input checked="" type="checkbox"/>	
Order Copies	<input type="checkbox"/>	
Annuities 9-30-98	<input type="checkbox"/>	
Other	<input type="checkbox"/>	

APR 4 1998

SERIAL NO.
75/977076 Mondial Trading Co. Ltd.

APPLICANT

MARK

EARTH

ADDRESS

David Wolf
c/o Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2211

ACTION NO.
01

MAILING DATE
03/30/98

REF. NO.

206
M0049 9875

ADDRESS:

Assistant Commissioner
for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

Please provide in all correspondence:

1. Filing Date, serial number, mark and Applicant's name.
2. Mailing date of this Office action, examining Attorney's name and w Office number, ur telephone number and ZIP code.

TRADEMARK LAW OFFICE 108
Serial Number: 75/977076
Mark: EARTH

Please Place on Upper Right Corner
**of Response to Office Action ONLY **

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ABANDONMENT.
has been enclosed.
losed, print or type
ne your response.

This letter responds to the applicant's communication filed on January 22, 1998.

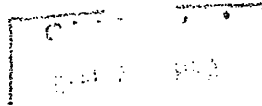
The drawing displays the mark as EARTH. However, this differs from the display of the mark on the specimens, where it appears as EARTH SHOE. The applicant cannot amend the drawing to conform to the display on the specimens because the character of the mark would be materially altered. 37 C.F.R. Section 2.72(a); TMEP section 807.14(a).

Therefore, the applicant must submit substitute specimens which show use of the mark as it appears on the drawing. 37 C.F.R. Section 2.51; TMEP section 807.14. The applicant must verify, with an affidavit or a declaration under 37 C.F.R. Section 2.20, that the substitute specimens were in use in commerce prior to the expiration of the time allowed to the applicant for filing a statement of use. 37 C.F.R. Sections 2.59(b) and 2.72(c); TMEP section 905.10.

In addition, based upon the specimens submitted with the Statement of Use, the examining attorney issues the following refusal.

ORNAMENTATION REFUSAL

M003520
05cv11781



Wolf, Greenfield & Sack, P.C.
LEGAL SERVICES DIV.

APR 2 - 1998

RECEIVED

M003521
05cv11781

75/971076

-2-

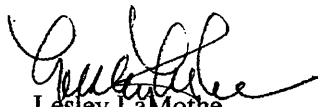
The examining attorney refuses registration on the Principal Register because the proposed mark is ornamental as used on the goods. Trademark Act Sections 1, 2 and 45, 15 U.S.C. Sections 1051, 1052 and 1127. The examining attorney must conclude on the present record that the public would perceive the proposed mark merely as a decorative or ornamental feature of the goods and not as an indicator of the source of the goods. *See In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985); *In re David Crystal, Inc.*, 296 F.2d 771, 132 USPQ 1 (CCPA 1961); *In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451 (TTAB 1987); *In re Astro-Gods Inc.*, 223 USPQ 621 (TTAB 1984); *In re Olin Corp.*, 181 USPQ 182 (TTAB 1973); TMEP section 1202.04 *et seq.*

The applicant may attempt to overcome the stated refusal in either of two ways. The applicant may submit evidence that the proposed mark has become distinctive of the applicant's goods in commerce. Evidence submitted to show that the mark has acquired distinctiveness as an indicator of the source of the applicant's goods may consist of examples of advertising and promotional materials that specifically promote the subject matter for which registration is sought *as a mark*, dollar figures for advertising devoted to such promotion, dealer and consumer statements of recognition of the subject matter as a mark and any other evidence that establishes recognition of the matter as a mark for the goods. *See* TMEP section 1202.04(d).

In the alternative, the applicant may attempt to overcome the refusal by showing that the proposed mark is an indicator of secondary source or sponsorship for the identified goods. That is, the applicant may submit evidence showing that the proposed mark would be recognized as a trademark or service mark through the applicant's use of the proposed mark with goods or services other than those identified here. The applicant must establish that, as a result of this use on other goods or services, the public would recognize the applicant as the secondary source or sponsor of the identified goods. *See* TMEP section 1202.04(c).

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

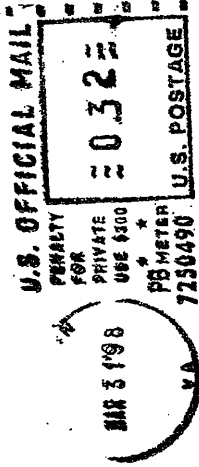

Lesley LaMothe
Trademark Attorney
Law Office 108
703-308-9108 ext. 163

M003523
05cv11781

UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON VA 22202-3513
IF UNDELIVERABLE RETURN IN TEN DAYS

OFFICIAL BUSINESS
PENALTY FOR PRIVATE USE, \$300

AN EQUAL OPPORTUNITY EMPLOYER



TM108

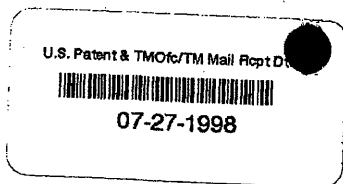
David Wolf
c/o Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2211

115

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02210X2206 47

EXHIBIT I



20 108

ATTORNEY'S DOCKET NO. M0849/2016 (DW)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mondial Trading Company, Ltd.
Serial No : 75/977076
Filed : July 20, 1994
Mark : EARTH
Examiner : Lesley LaMothe
Law Office : 108

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with First Class postage attached, addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on the 23 day of July.


David Wolf, Reg. No. 17,528

Box ITU Fee
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VA 22202-3513

Sir:

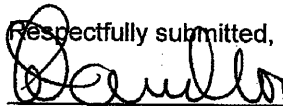
Transmitted herewith are the following documents:

Response to Office Action
Substitute Statement of Use with Specimens
Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617)720-3500, Boston, Massachusetts.

A check in the amount of \$00 is enclosed to cover the filing fee. If the fee is insufficient, the balance may be charged to the account of the undersigned, Deposit Account No. 23/2825. A duplicate of this sheet is enclosed.

Respectfully submitted,


David Wolf
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2211
(617)720-3500

July 23, 1998
x7/23/98

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LAW OFFICE 108

RECEIVED
1998 AUG 5 10:24
T.M.O.
LAW OFFICE 108

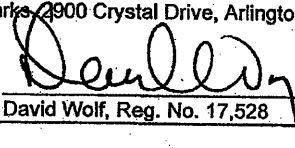
ATTORNEY'S DOCKET NO. M0849/2016 (DW)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mondial Trading Company, Ltd.
Serial No : 75/977076
Filed : July 20, 1994
Mark : EARTH
Examiner : Lesley LaMothe
Law Office : 108

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David Wolf, Reg. No. 17,528

Box ITU Fee
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VA 22202-3513

Sir:

Transmitted herewith are the following documents:

Response to Office Action
Substitute Statement of Use with Specimens
Postcard

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A check in the amount of \$00 is enclosed to cover the filing fee. If the fee is insufficient, the balance may be charged to the account of the undersigned, Deposit Account No. 23/2825. A duplicate of this sheet is enclosed.

Respectfully submitted,


David Wolf
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2211
(617)720-3500

July 23, 1998
x7/23/98

U.S. Patent & TMO/TM Mail #26



07-27-1998

ATTORNEY'S DOCKET NO. M0849/2016 (DW)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mondial Trading Company, Ltd.
Serial No : 75/977076
Filed : July 20, 1994
Mark : EARTH
Class : 25
Examiner : Lesley LaMothe
Law Office : 108
Notice of Allowance Issue Date : July 23, 1997

Box Response No Fee
Assistant Commissioner For Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

Applicant acknowledges the Office Action of March 30, 1998 and in response to the rejection of the specimens herewith submits substitute specimens that display the mark as EARTH in a manner consistent with the drawing as originally filed. The substitute specimens are supported by a declaration consistent with 37 CFR Sec. 2.20 in the form of a new Statement of Use.

In addition the substitute specimens do not function as ornamentation and therefore the objection previously made with respect to the original specimens is mooted.

Further consideration is solicited.

Respectfully submitted,

David Wolf, Reg. No. 17,528
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02110
(617) 720-3500

ATTORNEY'S DOCKET NO. M0849/2016 (DW)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mondial Trading Company, Ltd.
Serial No : 75/977076
Filed : July 20, 1994
Mark : EARTH
Class : 25
Examiner : Lesley LaMothe
Law Office : 108
Notice of Allowance Issue Date : July 23, 1997

STATEMENT OF USE UNDER 37 CFR §2.88, WITH DECLARATION

Box ITU Fee
Assistant Commissioner For Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

Applicant requests registration of the above-identified trademark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et. seq., as amended).

Three (3) specimens showing the mark as used in commerce are submitted with this statement.

A Request to Divide under 37 CFR 2.87 is not being submitted with this statement.

Applicant is using the mark in commerce on or in connection with those goods identified in Notice of Allowance .

The date of first use of the mark anywhere is: prior to 1/98.

The date of first use of the mark in commerce which the U.S. Congress may

regulate is: prior to 1/98.

The type of commerce in which the mark is used is: interstate.

The manner or mode of use of the mark on or in connection with the goods is:
applied to labels and in other ways customary to the trade.

The undersigned being hereby warned that willful false statements and the like
so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and
that such willful false statements may jeopardize the validity of the application or any
resulting registration, declares that he is properly authorized to execute this Statement
of Use on behalf of the applicant; he believes the applicant to be the owner of the
trademark sought to be registered; the trademark is now in use in commerce; and all
statements made of his own knowledge are true and all statements made on information
and belief are believed to be true.

Mondial Trading Company, Ltd.

✓ 16 July 1998
Date

By: ✓ Akudatto
Name: Kareen Walter
Title: Director

Applicant:	Mondial Trading Company, Ltd.
Address:	763 P.O. Box 1109, Mary Street, Grand Cayman CAYMAN ISLANDS, B.W.I
Date of First Use:	prior to 1/98
First Use in Commerce:	prior to 1/98
Class:	
Goods/Services:	clothing
Mark:	EARTH



EXHIBIT J

ATTORNEY'S DOCKET NO. M0849/2005 (DW)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mondial Trading Company, Ltd.
Serial No : 74/551611
Filed : July 11, 1995
Mark : EARTH
Examiner : David J. Cho
Law Office : 10

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with First Class postage attached, addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on the 20 day of January, 1999.



David Wolf, Reg. No. 17,528

Box ITU Fee
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VA 22202-3513

Sir:

Transmitted herewith are the following documents:

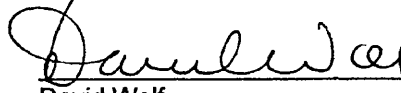
Statement of Use Under 37 CFR §2.88, with Declaration

Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617)720-3500, Boston, Massachusetts.

A check in the amount of \$100.00 is enclosed to cover the filing fee. If the fee is insufficient, the balance may be charged to the account of the undersigned, Deposit Account No. 23/2825. A duplicate of this sheet is enclosed.

Respectfully submitted,



David Wolf
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2211
(617)720-3500

January 20, 1999
x1/23/99

M003373
05cv11781

01/18/99 MON 18:15 FAX 345 949763

MIDLAND TRUST

002

ATTORNEY'S DOCKET NO. M0849/2005 (DW)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mondial Trading Company, Ltd.
Serial No : 74/551611
Filed : July 11, 1995
Mark : EARTH
Class : 25
Examiner : David J. Cho
Law Office : 10
Notice of Allowance Issue Date : January 23, 1996

STATEMENT OF USE UNDER 37 CFR §2.88, WITH DECLARATION

Box ITU Fee
Assistant Commissioner For Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

Applicant requests registration of the above-identified trademark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et. seq., as amended).

Three (3) specimens showing the mark as used in commerce are submitted with this statement.

A Request to Divide under 37 CFR 2.87 is not being submitted with this statement.

Applicant is using the mark in commerce on or in connection with those goods identified in Notice of Allowance .

The date of first use of the mark anywhere is: 12/98.

The date of first use of the mark in commerce which the U.S. Congress may

M003374
05cv11781

18:15 FAX 345 9497634

MIDLAND TRUST

003

regulate is: 1/4/99.

The type of commerce in which the mark is used is: commerce reguable by Congress and commerce with the United States..

The manner or mode of use of the mark on or in connection with the goods is: applied to all goods used on labels and in other ways customary to the trade.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this Statement of Use on behalf of the applicant; he believes the applicant to be the owner of the trademark sought to be registered; the trademark is now in use in commerce; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Mondial Trading Company, Ltd.

18th January 1999
Date

By:

Alexandro

Name: KAREEN WATLER

Title: DIRECTOR

JUN 18:16 FAX 345 94976

MIDLAND TRUST

MIDLAND TRUST

002

004

Applicant:	Mondial Trading Company, Ltd.
Address:	P. O. Box 1109, Mary Street Grand Cayman CAYMAN ISLANDS
Date of First Use:	1/4/99
First Use in Commerce:	1/4/99
Class:	25
Goods/Services:	goods
Mark:	EARTH



-3-

EXHIBIT K

M0849/4001 (DW)

ASSIGNMENT

WHEREAS, Mondial Trading Company, Ltd., a corporation of Grand Cayman Islands having an office and place of business at P.O. Box 1109, Mary Street, Grand Cayman, CAYMAN ISLANDS, B.W.I. has adopted and used the following marks and the trademark Registrations:

SCHEDULE OF TRADEMARKS

MARK	REG. NO.	REG. DATE
ANNE KALSO EARTH SHOE	1,294,415	September 11, 1984
EARTH	1,371,439	November 19, 1985
EARTH SHOE	1,372,733	November 26, 1985
E (LOGO)	2,051,653	April 8, 1997
EARTH SHOE	2,211,331	December 15, 1998
EARTH	2,199,118	October 20, 1998
EARTH	2,249,826	June 1, 1999

WHEREAS, Michel Meynard, Inc., a corporation of Massachusetts, having an office and place of business at 763 Salem End Road, Framingham, Massachusetts 01702 is desirous of acquiring said mark and the registrations therefor.

NOW, THEREFORE, for one Dollar (\$1.00) and other good and valuable consideration, the receipt of which is hereby acknowledged, said Mondial Trading Company, Ltd. without representations or warranties with respect to said trademarks or registrations or the title thereto does hereby assign unto the said Michel Meynard, Inc., all its rights, title and interest in and to the said marks and the registrations therefor, together with the goodwill of the business symbolized by said marks and the registrations therefor and including all rights to sue and recover for past infringement of said marks and the registrations therefor.

Mondial Trading Company, Ltd.

1ST MARCH, 2000
Date

By *E.J. Christian*
Name: E.J. CHRISTIAN
Title: MANAGING DIRECTOR

STATE OF ~~----~~ CAYMAN ISLANDS
COUNTY OF ~~---~~ GEORGE TOWN

Subscribed to and sworn before me this 1ST day of MARCH, 2000

SEAL

John Billings
Notary Public JOHN BILLINGS
My Commission Expires 10TH DECEMBER, 2004

M0005